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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* YOSHINOBU ISHIGAKI, MASAYUKI NUMAO,
MADOKA YURIYAMA, and YUJI WATANABE

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Appeal 2009-010782
Application 10/568,513
Technology Center 2400

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*Before* HOWARD B. BLANKENSHIP, THU A. DANG, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 23-32. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We REVERSE.

*Introduction*

According to Appellants, the invention is a system and method related to a personal information handling agent that has personal information. In response to a request from a user, some of the personal information is provided to a third party. (Abstract).

## STATEMENT OF THE CASE

*Exemplary Claim*

Claim 23 is an exemplary claim and is reproduced below:

23. A method for providing attribute data, said method comprising:

receiving a request from a user device via a network for a virtual ID token relating to attribute information pertaining to a subscriber associated with the user device;

responsive to the request for the virtual ID token, reading a data record from a database, said data record comprising L attributes of the subscriber, L being at least 2;

providing the data record to the user device via the network;

receiving, from the user device via the network, a selection of M attributes of the L attributes, M being less than L;

generating a virtual record including the M attributes selected from the data record, said virtual record comprising a virtual ID (VID) for identifying the virtual record;

storing the generated virtual record in the database; and

providing the virtual ID token to the user device via the network, wherein the virtual ID token comprises the VID, wherein an attribute information providing server performs said receiving the request for the virtual ID token, said reading the data record from the database, said providing the data record to the user device, said receiving the selection of M attributes, said generating the virtual record, said storing the generated virtual record in the database, and said providing the virtual ID token to the user device.

*Prior Art References*

| | | |
|---|---|---|
| Win | 6,453,353 B1 | Sep. 17, 2002 |
| Naor | 6,834,272 B1 | Dec. 21, 2004 |

*Rejections*

Claims 23-25 and 27-32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Win.

Claim 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Win and Naor.

ISSUE 1

*35 U.S.C. § 102(e): claims 23-25 and 27-32*

Appellants argue their invention is not anticipated by Win because Win does not disclose "receiving a request from a user device via a network for a virtual ID token relating to attribute information pertaining to a

subscriber associated with the user device" (App. Br. 5-6). Appellants contend Win does not describe a "virtual ID token" or "receiving a request" (*id.*).

In response, the Examiner finds that although a virtual ID token may include a virtual ID, Appellants do not define "virtual ID token" (Ans. 10). Accordingly, the Examiner concludes "a token is an encrypted identification of one valid user or group on an external authentication system" (Ans. 11). The Examiner then finds Win discloses a virtual ID token.

*Issue 1:* Has the Examiner erred in finding Win discloses "receiving a request from a user device via a network for a virtual ID token relating to attribute information pertaining to a subscriber associated with the user device" as recited in claim 23?

## ANALYSIS

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

For essentially the same reasons argued by Appellants in the Appeal Brief (6-7) and Reply Brief (3 and 4), we agree that the Examiner did not present a prima facie case of unpatentability in the rejection of independent claim 23 under § 102. Specifically, although the Examiner cites multiple portions of Win as disclosing a virtual ID token, it is unclear what portion

the Examiner is relying upon to disclose receiving a user device request for a virtual ID token. Absent a convincing explanation from the Examiner in support of why the cited portions of Win are deemed to teach the disputed features, we are left to speculate how and why the reference is being applied. We will not engage in speculation.

The Examiner has thus not shown Win discloses "receiving a request from a user device via a network for a virtual ID token relating to attribute information pertaining to a subscriber associated with the user device" as recited in claim 23. Accordingly, we reverse the rejection of claim 23, as well as associated dependent claims 24, 25, and 27-32, which stand therewith.

## ISSUE 2

*35 U.S.C. § 103(a): claim 26*

Claim 26 depends indirectly from claim 23. As discussed above in Issue 1, the Examiner has not shown Win discloses the invention as recited in claim 23. The Examiner has not shown that Naor cures the deficiency of Win. Accordingly, we reverse the rejection of claim 26.

## CONCLUSION

Appellants have shown the Examiner erred in finding claims 23-25 and 27-32 are anticipated by Win. Accordingly, Appellants have shown the Examiner erred in rejecting claims 23-25 and 27-32 under 35 U.S.C. § 102(e) for anticipation by Win.

Appellants have shown the Examiner erred in finding claim 26 obvious over Win and Naor. Accordingly, Appellants have shown the Examiner erred in rejecting claim 26 under 35 U.S.C. § 103(a) for obviousness over Win and Naor.

## DECISION

The Examiner's rejection of claims 23-25 and 27-32 under 35 U.S.C. § 102(e) as being anticipated by Win is reversed.

The Examiner's rejection of claim 26 under 35 U.S.C. § 103(a) as being obvious over Win and Naor is reversed.

REVERSED

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